

## REMARKS

Claims 37-85 are pending in the present application. Reconsideration of the pending claims is respectfully requested.

In the outstanding Office action dated July 18, 2006, claim 57 was rejected for double patenting. More specifically, claim 57 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20 and 21 of U.S. Patent No. 6,827,734 in view of Palmaz (5,102,417). Additionally, claim 57 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,419,693 in view of Palmaz and claim 57 was again rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 5,636,641 in view of Palmaz.

It is respectfully submitted, however, that the subject matter recited in claim 57 is not an obvious variation of the invention defined in claims 20 and 21 of U.S. Patent No. 6,827,734 in view of Palmaz; claim 1 of U.S. Patent No. 6,419,693 in view of Palmaz; or claims 1 and 3 of U.S. Patent No. 5,636,641 in view of Palmaz. It is to be noted that claim 57 further limits independent claim 53 which recites a cylindrically shaped balloon-expandable stent comprising a plurality of independently expandable and interconnected cylindrical elements wherein the cylindrical elements have an elasticity insufficient to allow expansion from a first low profile delivery configuration to a second expanded configuration without permanent plastic deformation, the cylindrical elements having an undulating component. Neither claims 20 and 21 of U.S. Patent No. 6,827,734, nor claim 1 of U.S. Patent No. 6,419,693, nor claims 1 and 3 of U.S. Patent No. 5,636,641 recite cylindrical elements which assume a first low profile delivery configuration through compression and which have an elasticity insufficient to allow expansion from a first low profile delivery configuration to a second radially expanded configuration

without permanent plastic deformation wherein the cylindrical elements have an undulating component. Moreover, the Palmaz patent does not teach such an approach. Accordingly, such recited subject matter render the pending claims patentably distinct from the claims and disclosures of these patents. Therefore, it is respectfully requested that the double patenting rejection of claim 57 be withdrawn.

Also, in the outstanding Office action, claims 37-43 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses the § 112 rejection. Nevertheless, for clarity, independent claim 37 has been amended to recite a cylindrically shaped balloon expandable stent wherein the elements of the stent assume the first low profile delivery configuration through compression. As such, it is believed that the § 112, first paragraph rejection of claims 37-43 can be withdrawn.

In the outstanding January 2007 Office action, claims 37-49, 53, 56-61, 72-74, 78-80 and 83 were again rejected under 35 U.S.C. § 102(e) as being anticipated by Robinson et al. (5,891,193). Also, claims 51 and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson et al. in view of Hillstead (4,856,516) or Tower (5,217,483); claims 54, 62-71, 75, 76, 81, 82, 84 and 85 were rejected under § 102(e) as anticipated by Robinson et al. or in the alternative, under § 103(a) as obvious over Robinson et al.; claims 55 and 77 were rejected under § 103(a) as being unpatentable over Robinson et al. in view of Bokros (4,300,244); and claim 50 was rejected under § 103(a) in view of Robinson et al.

In rejecting claims 37-49, 53, 56-61, 72-74, 78-80 and 83 under § 102(e), the Examiner again stated that since the stent disclosed in Robinson et al. can be bent to form the stent, the stent is therefore plastically deformable and can be expanded to a state where there would be no bends in the wires forming the stent. The Examiner then concluded that "this unbent expanded diameter reads on the 'diameter suitable to hold open the coronary artery' as claimed." The

Examiner then further stated that "self-expansion depends on how the device is used and how it is biased." However, it is submitted that there is no recognition in the cited Robinson et al. patent of using or biasing the disclosed stent in a manner other than for self-expansion and as such, the Robinson et al. patent does not teach each and every limitation recited in the claims as is required during a § 102(e). As previously argued by the Applicant, the Robinson et al. patent does not teach the balloon expandable stent recited in independent claims 37, 44, 53 and 83 or their respective dependent claims. Moreover, the Robinson et al. reference does not teach a stent including cylindrical elements which have an elasticity insufficient to allow expansion from the first low profile delivery configuration to a second radially expanded configuration without plastic deformation as recited in claims 37-43 and 72-76. Further, the Robinson et al. patent does not teach a stent having a first low profile configuration for delivery and a second radially expanded configuration which is plastically deformable from the first low profile configuration to the second radially expanded configuration as is recited in claims 44-50 nor cylindrical elements of the stent having an elasticity insufficient to allow expansion from a first profile configuration to a second radially expanded configuration without permanent plastic deformation as is recited in claims 53-61, 77-81 and 83. Again, the Robinson et al. patent teaches a self-expanding anchor which is "compressible to a low profile (small diameter) and can expand resiliently to an enlarged diameter"; (See Summary of Invention; Col. 3, lines 4-6). Since the Robinson et al. patent does not teach the above-identified subject matter, it does not constitute anticipatory art. Thus, it is respectfully submitted that claims 37-49, 53, 56-61, 72-74, 78-80 and 83 are allowable over the cited Robinson et al. patent.

For the same reasons, it is respectfully submitted that the rejection of claims 54, 62-71, 75, 76, 81, 82, 84 and 85 under § 102(e) or in the alternative under § 103(a), is traversed. The rejection of claim 50 under § 103(a) in view of Robinson et al. is also hereby traversed. The

allowability of dependent claims 50, 54, 75, 76 and 81 has been addressed above as these claims have been shown to be allowable due to the significant distinctions between the subject matter recited in their respective independent claims namely claims 37, 44 and 53, and the Robinson et al. patent. Claims 62-71, 82, 84 and 85 also are believed to recite subject matter which clearly distinguishes these claims from the Robinson et al. patent. Namely, each of claims 62-71, 82, 84 and 85 recite a stent that is plastically deformable from a low profile delivery configuration to a radially expanded configuration. The Robinson et al. patent simply does not contemplate plastically deforming a stent from a low profile delivery configuration to an expanded configuration. Robinson et al. also does not contemplate a balloon expandable stent as required by claims 82, 84 and 85. Therefore, it is respectfully submitted that the Robinson et al. patent neither anticipates nor renders obvious the subject matter of claims 50, 54, 62-71, 75, 76, 81, 82, 84 and 85.

It is also respectfully submitted that claims 51 and 52 as well as claims 55 and 77 are allowable over the combination of the Robinson et al. patent and the Hillstead, Tower or Bokros patents. Again, the Robinson et al. patent is simply lacking in the teaching of a balloon expandable stent as well as cylindrical elements having an elasticity insufficient to allow expansions from a low profile delivery configuration to a second radially expanded configuration without permanent plastic deformation as is recited in independent claim 51. Moreover, neither Robinson et al. nor the other cited art teach a balloon expandable stent including an interior chamber configured to receive an expandable member for plastically expanding the stent, the stent formed of an alloy containing cobalt, chromium, molybdenum and nickel as is recited in claim 52. Likewise, claims 55 and 77 are also believed to be patentable over the cited Robinson and Bokros patents in view of the deficiencies of the teachings of the Robinson et al. patent. Finally, it is respectfully submitted that the combination of Robinson with any of the Hillstead,

Tower or Bokros was made through improper hindsight. Significantly, there is a lack of teaching or recognition in Robinson to suggest the modification thereof in view of Hillstead, Tower or Bokros. Thus, it is believed, that claims 51, 52, 55 and 77 are not obvious over the cited art for this reason as well.

### CONCLUSION

Applicants have attempted to completely respond to the rejections set forth in the outstanding Office action. In view of the above amendments and remarks, Applicant respectfully request that the application be reconsidered, the claims allowed and the application passed to issue.

Respectfully submitted,  
FULWIDER PATTON LLP

By: /John V. Hanley/  
John V. Hanley  
Registration No. 38,171

JVH:kst  
Howard Hughes Center  
6060 Center Drive, Tenth Floor  
Los Angeles, CA 90045  
Tele.: (310) 824-5555  
Fax: (310) 824-9696  
Customer No. 24201  
175921.1